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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.		
09/887,738	06/22/2001	Helmut Rothenberger	HANZ-201 (10104501)	7486		
24972	7590 01/30/2003					
FULBRIGHT & JAWORSKI, LLP			EXAMINER			
666 FIFTH AV	· <del>-</del>	TILL, TERRENCE R				
NEW YORK, NY 10103-3198			HEL, TERRENCE R			
			ART UNIT	PAPER NUMBER		
			1744	2		
			DATE MAILED: 01/30/2003	/		

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.		Applicant(s)			
	09/887,738		ROTHENBERGER, HELMUT			
` Office Action Summary	Examiner		Art Unit			
	Terrence R. Till		1744			
The MAILING DATE of this communication app Period for Reply	pears on the cover	rsh t with th	correspondenc a	ddr ss		
A SHORTENED STATUTORY PERIOD FOR REPL THE MAILING DATE OF THIS COMMUNICATION.  - Extensions of time may be available under the provisions of 37 CFR 1.1 after SIX (6) MONTHS from the mailing date of this communication.  - If the period for reply specified above is less than thirty (30) days, a repl - If NO period for reply is specified above, the maximum statutory period of Failure to reply within the set or extended period for reply will, by statute - Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).  Status	36(a). In no event, howe by within the statutory min will apply and will expire e, cause the application to	ever, may a reply be tin imum of thirty (30) day SIX (6) MONTHS from b become ABANDONE	nely filed s will be considered time the mailing date of this D (35 U.S.C. § 133).			
1) Responsive to communication(s) filed on 23 i	December 2002 .					
2a)☐ This action is <b>FINAL</b> . 2b)⊠ Th	nis action is non-fi	nal.				
3) Since this application is in condition for allows closed in accordance with the practice under Disposition of Claims				he merits is		
4)⊠ Claim(s) <u>11-20</u> is/are pending in the application	on.					
4a) Of the above claim(s) is/are withdra	wn from consider	ation.				
5) Claim(s) is/are allowed.						
6)⊠ Claim(s) <u>11-20</u> is/are rejected.						
7) Claim(s) is/are objected to.						
8) Claim(s) are subject to restriction and/o	or election require	ment.				
Application Papers						
9)☐ The specification is objected to by the Examine	er.					
10) The drawing(s) filed on is/are: a) acce	pted or b) 🔲 object	ed to by the Exa	miner.			
Applicant may not request that any objection to th						
11) $igtimes$ The proposed drawing correction filed on <u>12/23</u>			approved by the E	Examiner.		
If approved, corrected drawings are required in re		tion.				
12) The oath or declaration is objected to by the Ex	caminer.					
Priority under 35 U.S.C. §§ 119 and 120						
13) Acknowledgment is made of a claim for foreign	n priority under 35	5 U.S.C. § 119(a	a)-(d) or (f).			
a) ☐ All b) ☐ Some * c) ☐ None of:						
1. Certified copies of the priority documents have been received.						
2. Certified copies of the priority documents have been received in Application No						
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). * See the attached detailed Office action for a list of the certified copies not received.						
14) Acknowledgment is made of a claim for domesti	ic priority under 3	5 U.S.C. § 119(	e) (to a provisiona	al application).		
a) ☐ The translation of the foreign language pro 15)☐ Acknowledgment is made of a claim for domest	ovisional applicati	on has been rec	eived.			
Attachment(s)						
1) Notice of References Cited (PTO-892) 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s)	4)		y (PTO-413) Paper N Patent Application (P <sup>:</sup>			
J.S. Patent and Trademark Office PTO-326 (Rev. 04-01) Office Ad	ction Summary		Part	of Paper No. 7		

#### **DETAILED ACTION**

# Claim Rejections - 35 USC § 112

- 1. The following is a quotation of the second paragraph of 35 U.S.C. 112:
  - The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
- 2. Claims 11-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
- 3. In claim 11, applicant recites "the windings having at least on their exterior a cross section different from a circular shape". This is confusing since a cross section is taken through the entire object, not just on the exterior of the object. The specification refers to the cross section as that going through the entireity of the wire.

#### Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- 5. Claim 11, as best understood, is rejected under 35 U.S.C. 102(b) as being anticipated by MacLeod.
- 6. MacLeod is considered to disclose all the recited subject matter (figure 5) of a coil spring forming a spring shaft with winding of spring steel with a rotational axis and a coiled winding axis. The windings having a cross-section different from a circular shape. As can be seen in

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Figure 5, it is the profile of a diamond. With respect to the recitation of the spring shaft acting with at least one edge scrapingly on contamination of the pipe walls, such is considered the intended use of the claimed device. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). It should be noted that, in column 3, lines 20-31, MacLeod says the device can be a saw, file or rasp, indicating that the device can scrape.

## Claim Rejections - 35 USC § 103

- 7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
  - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
- 8. The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
  - 1. Determining the scope and contents of the prior art.
  - 2. Ascertaining the differences between the prior art and the claims at issue.
  - 3. Resolving the level of ordinary skill in the pertinent art.
  - 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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- 9. Claim 13 is, as best understood, rejected under 35 U.S.C. 103(a) as being unpatentable over MacLeod.
- 10. MacLeod discloses the claimed invention except for the cross section being a square whose one cross section diagonal runs at least substantially radially to the rotation axis. It would have been an obvious matter of engineering choice to modify the cross section of the coil spring, shown in figure 5, of MacLeod to be a square, since such a modification would have involved a mere change in the shape or form of a component. A change in shape or form is generally recognized as being within the level of ordinary skill in the art. In re Dailey, 149 USPQ 47 (CCPA 1976).

### Allowable Subject Matter

Claims 12 and 14-20, as best understood, would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

#### Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Terrence R. Till whose telephone number is (703) 308-1592. The examiner can normally be reached on Mon. through Thurs. and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert J. Warden can be reached on (703) 308-2920. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Terrence R. Till Primary Examiner Art Unit 1744

trt January 28, 2003